

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Ole K. Nilssen
Entitled: ELECTRONIC BALLAST FOR
FLUORESCENT LAMPS
Serial Number: 06/541,489
Filing Date: 10/13/83
Art Unit: 266
Examiner: V. DELUCA

REPLY BRIEF

I, OLE K. NILSSEN, HEREWITH
CERTIFY THAT THE DATE OF
DEPOSIT WITH THE U.S. POSTAL
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IS: 8-20-86

[Signature]

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Members of Board of Appeals:

In response to Examiner's Answer to Applicant's Appeal Brief, Applicant provides the following Reply Brief.

Applicant was on vacation between August 2 and August 19, and did not receive Examiner's Answer (which was dated July 31) until August 19. Hence, it was not possible for Applicant to provide a Reply Brief within the normally required 20 days after date of Examiner's Answer.

In the second paragraph on page 2 of his Answer, Examiner states that "one of ordinary skill in the art would be led by the teaching of Agnew to connect the cathode filaments of a discharge lamp load in circuit with the feedback loop of the circuit of Nilssen figure 8".

Key questions that must be answered in this connection, and which have not been answered by Examiner, are the following:

1. In what way would a person of ordinary skill in the art "be led by the teaching of Agnew to connect the cathode filaments of a discharge lamp in circuit with the feedback loop of the circuit of Nilssen figure 8"?

2. What obvious problem would be solved by so doing?

3. Where and how is it suggested in or by the Nilssen reference that it would be advantageous to combine it with an arrangement such as that described by Agnew?

4. Or, similarly, where and how is it suggested in or by the Agnew reference that it would be advantageous to combine it with an arrangement such as that described by Nilssen?

Further on, still in the second paragraph on page 2 of his Answer, Examiner asserts that "Appellant agrees that this combination is obvious to one skilled in the art, as evidenced by the cancellation of all claims directed to this subject matter".

Applicant does not agree that "this combination is obvious to one skilled in the art"; and the referenced "cancellation of all claims directed to this subject matter" can not in any way be regarded as evidence of such agreement.

As is most often the case in the various and numerous applications that Applicant prosecutes before the PTO, claims are cancelled for reasons most often related to the perceived limitations and/or peculiarities of the prosecuting Examiner, and not because they are believed to be non-allowable in any basic sense. Rather, Applicant has generally found that it is advantageous to yield to an Examiner's perceived limitations and/or peculiarities, as long as this can be accomplished without significantly compromising the sought-after protection.

A significant factor related to obviousness in respect to combining the two applied references is the fact that these two references are taken from completely different Classifications; and that they are not mutually cross-referenced to one another.

The Nilssen reference is from U.S. Cl. 331/113 A; the Agnew reference is from U.S. Cl. 315/97.

Even if the combination of Nilssen with Agnew were to be considered as an obvious combination (which Applicant contends it is not), there is no basis for considering it obvious to arrange the inverter circuit in such a way as to receive its requisite trigger pulses only when the load is connected. If that were to be as obvious as Examiner asserts, then why has it not been shown in any of the numerous inverter circuits that require trigger pulses to initiate operation?

An example of such an inverter circuit is shown by Fig. 5 of U.S. Patent No. 4,370,600 to Zansky. In that circuit arrangement, in order to attain Applicant's claimed invention, all that Zansky would have had to do is to connect resistor 134 between capacitor 136 and junction 148 instead of between capacitor 136 and the junction between capacitors 131 and 132.

Why, then, did Zansky not do that which Examiner asserts (in the second paragraph of page 3 of his Answer) to be both a "significant design consideration to one of ordinary skill in the art" as well as obvious?

Contrary to Examiner's assertion, the answer must clearly be that to do so is not obvious -- even to an inventor like Zansky.

In respect to the Zansky reference, of which Applicant first became aware while searching -- in connection with instant Reply Brief -- for examples of inverters requiring to be triggered into operation, Applicant wishes to point out that it represents a far better reference relative to Applicant's claimed invention that does the combination of Nilssen and Agnew; and, as such, it provides a far better crystallization of the issues under appeal.

In other words, based on the Zansky reference, the question to be resolved by instant appeal is simply whether or not it would have been obvious to someone of ordinary skill in the art to so arrange the triggering arrangement of the Zansky circuit in such a fashion that triggering would only occur when the load is connected.

According to Examiner's assertion (in second paragraph of page 3 of his Answer) to the effect that "good engineering practice dictates against useless power dissipation whenever it can be avoided", it would be obvious to seek to so arrange the triggering.

However, Zansky did not think of doing so; and one reason for that might be due to the fact that the amount of power associated with the triggering function is so miniscule as to be substantially negligible. In Applicant's circuit, as well as in other inverter circuits that have to be triggered into operation, the dissipation associated with the triggering function is only about five milli-Watt for an inverter capable of providing an output of 100 Watt.

In other words, to save the amount of power associated with the triggering function would only appear to be important to a person who is not skilled in the art related to inverters that have to be triggered into oscillation.

Hence, the motivation of saving power -- which is the motivation used by Examiner -- is totally irrelevant as a means for seeking to achieve the results of the claimed invention.

And, with reference to Authority #5, without an obvious problem to be solved, there is no basis for asserting that the claimed invention (which solves this problem) is obvious.


Otherwise, in respect to the combination of the two applied references, the Examiners in Chief are asked to consider the following authorities.

a) In Richdel, Inc. v. Sunspool Corp. (714 F.2d 1573 -- Fed Cir. 1983), Chief Judge Markey presented a detailed rejection of the doctrine of combination patents: "It was error for the district court to derogate the likelihood of finding patentable invention in a combination of old elements. No species of invention is more suspect as a matter of law than any other. Attempted categorization for the purpose of determining various "rules" detracts from what should be the sole question: whether the claimed invention would have been obvious within the meaning of paragraph 103. Most, if not all, inventions are combinations and mostly of old elements".

b) In Adams (356 F.2d 998 -- CCPA 1966), the Board (of Appeals) was reversed because "neither reference contains the slightest suggestion to use what it discloses in combination with what is disclosed in the other." (356 F.2d at 1002)

c) In Imperato (486 F.2d 585 -- CCPA 1973): although combining the references' teachings yielded the result claimed, the CCPA held that the combination was not obvious "unless the art also contains something to suggest the desirability of the combination".

d) In Sernaker (702 F.2d at 995-96), the CAFC interpreted Imperato to mean that "prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings".


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Date: 8-20-85